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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,248	08/03/2000	Wolfgang Maus	E-41007	1144
24131	7590	02/02/2006	EXAMINER	
LERNER GREENBERG STEMER LLP P O BOX 2480 HOLLYWOOD, FL 33022-2480			TRAN, HIEN THI	
			ART UNIT	PAPER NUMBER
			1764	

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/632,248

Applicant(s)

MAUS, WOLFGANG

Examiner

Hien Tran

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,6-15,18,19,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-15,18,19,21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This office action is based on the decision and remand from the Board of Patent Appeals and Interferences on 9/7/05.

#### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-3, 7-8, 12-15, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Locker et al (6,077,483).

With respect to claims 1-2, 7-8, 12-14, 19, Locker et al discloses a catalytic exhaust gas purification device comprising:

a steel casing 16;

a monolithic ceramic honeycomb element 10 mounted in said casing 16;

Art Unit: 1764

a compensating layer disposed between said casing 16 and said honeycomb element 10;  
said compensating layer comprising:

a swelling mat or intumescent mat 14 with border regions at risk from abrasion;  
an insulative barrier coating layer 12 having a border and an inner region; said  
border of said insulative barrier coating layer 12 having a thicker region 12A than  
said inner region; and

said swelling mat 14 being disposed adjacent a side of said inner region of said  
insulative barrier coating layer 12 facing away from said honeycomb element 10  
and said thicker region 12A of said border of said insulative barrier coating layer  
12 covering said border regions of said swelling mat 14 at risk from abrasion (Fig.  
2);

said compensating layer is wrapped around the honeycomb element 10 (col. 7, lines 15-  
53).

The apparatus of Locker et al is substantially the same as that of the instant claims, but is  
silent as to whether the insulative barrier coating layer 12 may be in a mat form.

However, applicant does not provide any definition of the insulating “mat” term to give  
any special meaning to that term, except reference to a Merriam-Webster online dictionary in the  
brief filed 11/12/04, which is consistent with the definition of “mat” found at page 716 of  
Merriam-Webster’s Collegiate Dictionary, Tenth Edition, as set forth in the Board’s decision on  
9/7/05. Furthermore, applicant acknowledges on page 12, lines 8-13 of the instant specification  
that an insulating mat typical includes known prior art “fiber mats”.

Art Unit: 1764

Locker et al further discloses that the insulative barrier coating layer 12 may include a variety of additives, including fibrous materials of refractory glass, ceramic or metal fibers, etc. (col. 4, lines 54-65). Therefore, the insulative barrier coating layer with the fibers of Locker et al meets the "fiber mats or insulating mats" acknowledged by applicant on page 12, lines 8-13 of the instant specification.

It would have been obvious to one having ordinary skill in the art to add a variety of additives, such as fibrous material in the insulative barrier coating layer 12 of Locker et al so as to improve coating strength as taught by Locker et al.

With respect to claims 3, 15, Locker et al discloses that the insulating layer contains ceramic material (col. 4, lines 15-65).

4. Claims 6 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Locker et al (6,077,483) in view of Ten Eyck (4,999,168).

As best understood, the apparatus of Locker et al is substantially the same as that of the instant claims, but fails to disclose whether the swelling mat may swell upon absorbing water.

However, Ten Eyck discloses the conventionality of providing a swelling mat containing mica as that of the instant invention and therefore inherently swells upon absorbing water (col. 5, lines 40-44).

It would have been obvious to one having ordinary skill in the art to alternatively select an appropriate material for the swelling mat, such as mica, as taught by Ten Eyck in the apparatus of Locker et al on the basis of its suitability for the intended use as a matter of obvious design choice to obtain the desired supporting and insulating the catalyst element thereof, absence showing any unexpected results and since it has been held to be within the general skill

Art Unit: 1764

of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In *re Leshin*, 125 USPQ 416.

5. Claims 9-11, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Locker et al (6,077,483) in view of Santiago et al (4,344,922) and Ten Eyck (4,999,168).

The apparatus of Locker et al is substantially the same as that of the instant claims, but fails to disclose whether the compensating layer may be prefabricated segments.

However, Santiago et al and Ten Eyck disclose the conventionality of providing a compensating layer in form of prefabricated segment.

It would have been obvious to one having ordinary skill in the art to use the compensating layer in prefabricated segment form as taught by Santiago et al and Ten Eyck in the apparatus of Locker et al, on the basis of its suitability for the intended use as a matter of obvious design choice to obtain the desired supporting the catalyst element thereof, absence showing any unexpected results.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hien Tran whose telephone number is (571) 272-1454. The examiner can normally be reached on Tuesday-Friday from 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 1764

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HT

*Hien Tran*

**Hien Tran  
Primary Examiner  
Art Unit 1764**

*Robert J. Warden, Sr.*

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for New Grounds of  
Rejection and Responding Prosecution*

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